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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208325
Party	Defendant Raaka Chocolate Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	02/14/2013
Attachments	Raaka Chocolate Inc-02.14.13- Motion to Dismiss.pdf ( 6 pages )(344598 bytes ) VLE v. Moore - ttabvue-91192733-OPP-34.pdf ( 35 pages )(113407 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

VIRGIN ENTERPRISES LIMITED,  Opposer,  v.  RAAKA CHOCOLATE, INC.,  Applicant.	Opposition No.:  Mark: VIRGIN CHOCOLATE  Serial No.: 85/489294
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**APPLICANT RAAKA CHOCOLATE INC.'S MOTION TO DISMISS  
VIRGIN ENTERPRISES LIMITED'S NOTICE OF OPPOSITION**

Raaka Chocolate Inc ("Applicant" or "Raaka"), Pro Se, hereby submits the following motion and supporting memorandum of law. Applicant respectfully moves for the Trademark Trial and Appeal Board ("the Board") to dismiss Virgin Enterprises Limited's ("Opposer") Notice of Opposition for failure to state a claim upon which relief can be granted, pursuant to Federal Rule of Civil Procedure 12(b)(6) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") Section 503.

The Notice of Opposition should be dismissed as it both alleges facts and fails to allege facts which, read as a whole, fail to state a claim upon which relief can be granted. Accordingly, Applicant respectfully submits that this proceeding should be dismissed.

**ARGUMENT**

**I. Legal Standard**

TBMP § 503.02 states that "[a] motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of the complaint." Petitioner has not "allege[d] such facts as would, if proved, establish that . . . a valid ground exists for denying the registration sought," as required by that section. Furthermore, Opposer must plead facts from

which the Board is able to determine that there are plausible factual allegations on the face of the pleading, that if accepted as true, would entitle the pleader to relief. **Ashcroft v. Iqbal**, 556 U.S. 662 (2009). No such facts are alleged.

**II. Opposer's Notice of Opposition fails to state facts from which the Board can find a basis for relief.**

Opposer's Notice of Opposition contains no allegation that Opposer has registered a Trademark in the International Class 30<sup>1</sup> category for which Raaka has applied for the "Virgin Chocolate" trademark. Opposer cites a wide variety of categories for which it has applied for or received Trademark protection, none of which either implicate chocolate nor any other product in International Class 30.

In Paragraph 2 of its Notice of Opposition, Opposer asserts that "... Virgin has used the VIRGIN word and design marks, on and in association with the retail sale or distribution of a broad range of goods and services offered in United States commerce including, but not limited to, chocolate..." Opposer makes no specific factual allegations as to the existence of any product which carries the VIRGIN word or design mark which has been or is being sold or distributed. Opposer also makes no specific substantive allegation of how the VIRGIN trademark appears in connection with such "retail sale or distribution." Opposer does not allege that any chocolate or chocolate product is sold or distributed bearing the VIRGIN mark.

In Paragraph 4 of its Notice of Opposition, Opposer references its well known airline fleet and then alleges that its flights ".... offer chocolate goods and hot chocolate beverages, as well

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<sup>1</sup> International Class 30 comprises: "Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice. **Explanatory Note** - Class 30 includes mainly foodstuffs of plant origin prepared for consumption or conservation as well as auxiliaries intended for the improvement of the flavour of food. **This Class includes, in particular:**

- beverages with coffee, cocoa, chocolate or tea base;
- cereals prepared for human consumption (for example, oat flakes and those made of other cereals)."

Source: **Nice Agreement Tenth Edition - General Remarks, Class Headings and Explanatory Notes** - Version 2012 - <http://www.uspto.gov/trademarks/notices/international.jsp>

as coffee, food, and other drinks to passengers” Opposer also alleges that its Virgin Atlantic Clubhouse “.... offers cafe services providing desserts, including chocolate products, food, coffee and other drinks.” These allegations make no specific claim as to any chocolate or chocolate products bearing the VIRGIN mark.

Paragraph 5 of Opposer’s Notice of Opposition lists various “VIRGIN-branded goods” offered by the airline Virgin America, but is devoid of reference to a VIRGIN-branded chocolate or any other VIRGIN-branded product in International Class 30. In that same paragraph, Opposer specifically alleges that Virgin America Inc, “has offered various “VIRGIN-branded goods including, but not limited to VIRGIN apparel, VIRGIN luggage, VIRGIN bags, VIRGIN cases for electronics, VIRGIN toys, VIRGIN water bottles, and VIRGIN pet products.” Opposer makes no allegation that it has ever sold a VIRGIN-branded chocolate product.

Opposer attaches as an exhibit Virgin Enterprises Ltd. v. Nawab, et. al. 335 F.3d 141, 146 (2d Cir.2003) purportedly in support of their Notice of Opposition. However, Nawab is readily distinguishable from the allegations in the Notice of Opposition in two material aspects. First, in Nawab, supra at p. 3, Virgin actually had a registered trademark in the class or field for the items for which defendants Nawab, et. al. were applying for their trademark. The Second Circuit noted that: “Plaintiff VEL... owns U.S. Registration No. 1,851,817 ... for the VIRGIN mark as applied to ‘retail store services in the fields of ... computers and electronic apparatus...’ Plaintiff also owns U.S. Registration No. 1,852,776... for a stylized version of the VIRGIN mark for use in connection with ‘retail store services in the fields of ... computers and electronic apparatus.’ ” Second, in Nawab supra, p. 4, the Second Circuit specifically noted that:

“In August 2000... plaintiff licenced Virgin Mobile USA, Ltd. to use the VIRGIN mark for wireless telecommunications services in the United States...”

The aforesaid license was for a commercial activity in the class for which Opposer had a registered trademark. In Virgin Enterprises Limited v. Steven E. Moore, Opposition No.

91192733 (August 31, 2012) [not precedential] (attached hereto as Annex A), the Trademark Board dismissed Opposer's Notice of Opposition. In Moore, as in the case at bar, Opposer had failed to register or attempt to register in the class for which the applicant (Virgin Farms) had applied for its Trademark. In Moore, International Class 31 was the relevant class.

Given the fact that Opposer has failed to register any trademark in International Class 30, it becomes incumbent upon Opposer to allege at least some facts other than Raaka's use of the term Virgin in connection with its chocolate to create a plausible claim of confusion or dilution of its VIRGIN trademark. However, Opposer fails completely to allege any probative facts from which the Board could find any likelihood of confusion with Raaka's Virgin Chocolate or a legal basis for dilution of its VIRGIN trademark. Nor does the Notice of Opposition allege that Raaka either has created or intended to create an association with Opposer or its VIRGIN mark.

### **CONCLUSION**

The body of factual allegations made by Opposer are insufficient to entitle the Opposer to relief. Opposer cites no application or registration for any trademark in International Class 30, nor has it alleged that it has participated in the sales or distribution of chocolate or other goods in International Class 30 which bear the Opposer's trademark. Opposer's Notice of Opposition fails to allege facts sufficient to entitle the pleader to relief.

Dated: February 14, 2013

Respectfully submitted,

RAAKA CHOCOLATE, INC



By: \_\_\_\_\_  
Ryan Cheney  
Chief Executive Officer  
Pro Se

50 Lexington Ave - Apt. 23A  
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(917) 340-2637

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Motion to Dismiss has been served upon NORVELL IP LLC, Attorneys for VIRGIN ENTERPRISES LIMITED, via first class mail, postage prepaid, addressed to:

SARAH E. DALE  
NORVELL IP LLC  
1776 Ash Street  
Northfield, Illinois 60093



Dated: February 14, 2013

By: \_\_\_\_\_  
Ryan Cheney  
Chief Executive Officer, Raaka Chocolate

50 Lexington Ave - Apt. 23A  
New York, NY 10010  
(917) 340-2637

# ANNEX A

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
April 10, 2012

Mailed:  
August 31, 2012

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Virgin Enterprises Limited

v.

Steven E. Moore

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Opposition No. 91192733  
to application Serial No. 77695546  
filed on March 20, 2009

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Joseph V. Norvell, Joseph T. Kucala, Jr., and Sarah E. Dale, of Norvell IP LLC for  
Virgin Enterprises Limited.

Steven E. Moore, *pro se*.

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Before Holtzman, Bergsman and Wellington,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Steven E. Moore (“applicant”) filed a use-based application on the Principal Register for the mark VIRGINFARMS and design, shown below, for “agricultural grains for planting; agricultural seeds; bulbs for agricultural purposes; plantable seed paper comprised primarily of seeds for agricultural purposes; seeds for agricultural purposes; spores and spawn; unprocessed seeds for agricultural use,” in Class 31.



Applicant disclaimed the exclusive right to use the term “VIRGIN FARMS.”



## Opposition No. 91192733

Virgin Enterprises Limited (“opposer”) filed a notice of opposition against the registration of applicant’s mark on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and dilution pursuant to Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c). Opposer alleged ownership and prior use of forty-seven trademark and service mark registrations that constitute or include the word “VIRGIN.”<sup>1</sup> For purposes of this opposition, we focus on the following six registrations for VIRGIN and VIRGIN-formative marks, because these marks are the closest to applicant’s mark and cover goods and services that, when considered vis-à-vis the applied-for mark and identified goods, are most likely to support a finding of likelihood of confusion. *See, e.g., In re Max Capital Group Ltd.*, 93 U.S.P.Q.2d 1243, 1245 (TTAB 2010).

1. Registration No. 1851817 for the mark VIRGIN, in typed drawing form, for the following services:<sup>2</sup>

Transportation of goods and passengers by road and air, freight transportation services; travel agency services, in Class 39; and

Bars; retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus, and watches, sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, games, video game machines and video game cartridges, in Class 42;

2. Registration No. 2770775 for the mark VIRGIN MOBILE, in typed drawing form, for the following goods and services:<sup>3</sup>

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<sup>1</sup> Opposer did not plead a family of marks.

<sup>2</sup> Issued August 30, 1994; first renewal.

<sup>3</sup> Issued October 7, 2003; Sections 8 and 15 affidavits accepted and acknowledged. Opposer disclaimed the exclusive right to use the word “MOBILE.”

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Mobile telephones, telephones and modems, and accessories therefor, namely, batteries; battery chargers; cigarette lighter adapters; hands-free headsets; carrying cases and belt clips, in Class 9;

Providing directory information via telephone, in Class 35; and

Telecommunications services, namely, transmission of voice, data, images, audio, video, and information via telephone or the Internet; personal communications services; pager services; electronic mail services; transmission or broadcast of news and information for others via telephone, including the Internet, in Class 38;

3. Registration No. 2808270 for the mark VIRGIN ATLANTIC, in typed drawing form, for “transportation of and arranging transportation of goods and passengers by road and air; freight transportation services by air; transportation of human beings by means of land vehicles; chauffeur services; travel agency services, namely, making reservations and bookings for transportation; arranging and/or conducting travel tours; operation of aircraft for others,” in Class 39;<sup>4</sup>

4. Registration No. 3188282 for the mark VIRGIN, in standard character form, for “alcoholic beverages, namely, vodka and wine,” in Class 33;<sup>5</sup>

5. Registration No. 3472228 for the mark VIRGIN UNITE, in standard character form, for the following services:<sup>6</sup>

Developing promotional campaigns for business; promoting public awareness of the need for businesses to have a positive impact on the communities and environment in which they operate and work together with the social sector to drive long term social change including making investments in emerging markets to accelerate positive social change through economic development; charitable services, namely, organizing and coordinating programs for the sick, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who are bereaved, children in need or at risk, those with sexual

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<sup>4</sup> Issued January 27, 2004; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>5</sup> Issued December 19, 2006.

<sup>6</sup> Issued July 22, 2008.

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problems, and underprivileged communities, and organizing and conducting volunteer programs and community service projects; business management and administration services in connection with a charity, in Class 35;

Charitable fund raising; charitable financial services for those in need, namely, accepting and administering monetary charitable contributions; financial sponsorship of fund raising events and events designed to raise the profile of charitable and social issues, in Class 36; and

Educational services, namely, conducting summits, conferences, lectures and seminars in the field of social change and charitable and social issues; training services in the field of social change and charitable and social issues; organizing community sporting and cultural events; educational services, namely, providing classes, lectures, seminars, workshops, and discussion groups in the fields of sickness, health problems, homelessness, drug use, disabilities, abuse, bereavement, children's needs, sexual problems, and poverty to young people, people with health problems or issues, the homeless, drug users, those with disabilities, victims of abuse, those who have been bereaved, children in need or at risk, those with sexual problems, and underprivileged communities; charitable services, namely, academic mentoring of children from underprivileged communities and young people, in Class 41; and

6. Registration No. 3541731 for the mark VIRGIN AMERICA, in standard character form, for the following services:<sup>7</sup>

Air transportation; freight transportation services by means of air, ship, truck, and rail; airport passenger and baggage check-in services; airport services, namely, ticketing and boarding services; travel services, namely, booking seating arrangements for airline passengers; air transportation services featuring frequent flyer miles as a bonus program for frequent air travelers; providing flight arrival and departure information; and transportation reservation services, in Class 39; and

Onboard in-flight entertainment services, namely, distributing movies, TV programs, and audio programs, and providing temporary use of video games, software and personal monitors for viewing the same, in Class 41.

With respect to its claim of likelihood of confusion, opposer alleged that applicant's mark VIRGINFARMS and design so resembles opposer's VIRGIN trade names and marks as to be likely to cause confusion. With respect to its dilution claim,

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<sup>7</sup> Issued December 2, 2008. Opposer disclaimed the exclusive right to use the term "AMERICA."

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opposer alleged that its VIRGIN mark was famous prior to applicant's filing date of March 20, 2009, and that the registration of applicant's mark is likely to dilute the distinctive quality of opposer's VIRGIN and VIRGIN-formative marks.

Applicant, in his answer, denied these allegations in the notice of opposition. Applicant also asserted several affirmative defenses, but did not pursue any of them by motion or at trial. The affirmative defenses, therefore, are deemed waived and given no further consideration.

### Evidentiary Matters

#### A. Exhibits to the Answer.

Applicant attached six exhibits to his answer to the notice of opposition, consisting of five state trademark registrations and a state certificate to brand livestock. For such material, Trademark Rule 2.122(c) provides that "an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony." 37 C.F.R. § 2.122(c); *see* Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 317, 704.05 (3d ed., rev. 2012). Applicant did not testify during the testimony period. Opposer has objected to the exhibits. Opposer's objection is sustained and we give no consideration to these exhibits.

#### B. Opposer's Submissions of Printed Publications on DVDs and CD-ROMs.

On October 22, 2010, opposer filed a notice of reliance on a significant volume of printed publications as evidence, submitted on seven DVDs (totaling more than 180,000 digital files), and on July 12, 2011, opposer submitted certain exhibits to testimonial

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depositions on CD-ROMs. Applicant has raised no objections to these submissions, either as to format or substance of material.

Trademark Rule 2.126 governs form of submissions. 37 C.F.R. § 2.126. For some time prior to August 31, 2007, the Board permitted certain submissions on CD-ROM. The Board deleted from Trademark Rule 2.126 the option of filing submissions in CD-ROM format by amendment to Rule 2.126, effective August 31, 2007.<sup>8</sup> Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42,242 (Aug. 1, 2007) (codified at 37 C.F.R. pt. 2). The amended rule was applicable to all cases pending or commenced on or after that date. 72 Fed. Reg. at 42,242. Part three of the Federal Register notice of the final package of the rule change is titled “Removal of Option to Make Submissions on CD-Rom,” and states the basis for the rule change was that file submissions in CD-ROM form “have presented technical problems for the ESTTA/TTABIS systems.” 72 Fed. Reg. at 42,247. The section reporting on comments includes the following response:

The Office is willing to reconsider allowing submissions by CD-ROM in inter partes trademark proceedings if technology eventually will allow such submissions to be efficiently incorporated in the Board’s electronic proceeding files. The removal of the option to file materials on CD-ROM is adopted in this final rule.

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<sup>8</sup> Notice has been posted on the Trademark Trial and Appeal Board webpage of the U.S. Patent and Trademark website, at <http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>, along with a posted chart summarizing the rule changes, [http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf).

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72 Fed. Reg. at 42, 256. This Federal Register notice has been posted on our website since it was published. Accordingly, all submissions of printed publications on CD-ROMs and DVDs<sup>9</sup> are not evidence in this proceeding and have not been considered in this decision.<sup>10</sup>

### C. Statements in Applicant's Brief.

Applicant made a number of statements in his brief, including statements on the now-excluded exhibits to his pleading. "Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest." TBMP § 704.06(b). Applicant submitted no testimony or evidence during the testimony period. Opposer has objected to this material as inadmissible, in accordance with Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a). We have considered applicant's brief mindful that factual statements, without supporting evidence properly made of record, are without value.

### D. Exhibits to the Reply Brief.

Opposer attached evidence to its reply brief. "Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony." TBMP § 704.05(b); *see, e.g., Syngenta Crop Prot., Inc. v. Bio-Chek, LLC*, 90 U.S.P.Q.2d 1112, 1116 (TTAB

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<sup>9</sup> We take judicial notice that Digital Video Discs (DVDs) are CD-ROMs capable of storing significantly larger amounts of data. WEBSTER'S NEW WORLD DICTIONARY OF COMPUTER TERMS 180 (8th ed. 2000).

<sup>10</sup> Based on a sampling of the submissions on these DVDs and CD-ROMs, it would appear that even if we were to have considered the materials identified in the notice of reliance as Exhibit Nos. 174 and 175, and Exhibits 6, 7, 8, 9, 10, and 13, to testimonial depositions, these submissions would not have changed the outcome of our decision.

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2009); *Bass Pro Trademarks, L.L.C. v. Sportsman Warehouse, Inc.*, 89 U.S.P.Q.2d 1844, 1848 (TTAB 2008); *see* 37 C.F.R. § 2.123(l) (“Evidence not obtained and filed in compliance with these sections will not be considered.”). Accordingly, the evidence attached to opposer’s reply briefs has been given no consideration.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant’s application file. In addition, opposer introduced the following testimony and evidence:

1. Notice of reliance on the following items:
  - a. Photocopies of opposer’s pleaded registrations printed from the electronic database records of the U.S. Patent and Trademark Office, showing that the registrations are subsisting and owned by opposer (Opposer’s Exs. 1–44);
  - b. Photocopies of 67 non-precedential Board decisions involving oppositions brought by opposer and granted in favor of opposer (Opposer’s Exs. 45–111); and
  - c. Photocopies of 62 court judgments in civil actions filed by opposer and granted in favor of opposer (Opposer’s Exs. 112–173).
2. Testimony deposition of Christine Choi, Director of Corporate Communications for Virgin Management USA, an affiliate company of opposer, with attached exhibits (Dep. Exs. 1-5, 11-12, 14-41).

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3. Testimony deposition of Mark James, Intellectual Property Manager for Virgin Management Limited, an affiliate company of opposer, with attached exhibits (Dep. Exs. 1-3, 36-37, 39, 40, and 42-56).

Applicant did not introduce any testimony or evidence during his testimony period. As noted above, applicant has not properly entered any evidence to the record. The parties briefed the case, and opposer requested and appeared at an oral hearing. Applicant did not attend the testimony depositions or the hearing.

Standing

As opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982).

Priority

As opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the goods and services covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973).



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### A. The Fame of Opposer's Marks.

The fifth *DuPont* factor requires us to consider the fame of opposer's mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods.*, 293 F.3d 1367, 63 U.S.P.Q.2d 1303, 1305 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," by widespread critical assessments and through notice by independent sources of the products and services identified by the marks, as well as by the general reputation of the branded products and services. *Bose*, 63 U.S.P.Q.2d at 1305-06, 1309. Although raw numbers of product and service sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 U.S.P.Q.2d 1901, 1904 (TTAB 2007).

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Opposer submitted the following testimony and evidence to prove the fame of its VIRGIN and VIRGIN-formative marks:<sup>11</sup>

1. Mr. James testified that Virgin Atlantic Airways Ltd. (“VAA”) is one of opposer’s trademark licensees operating in the United States.<sup>12</sup> Mr. James testified that VAA generated over \$450 million in U.S. sales of Virgin-branded goods and services in 2006, over \$450 million in 2007, \$383 million in 2008, and \$302 million in 2009.<sup>13</sup> Mr. James did not provide any specifics as to the type or kind of goods and services sold by VAA under the Virgin brand. Mr. James testified that VAA “spends approximately \$10 million each year to advertise in the U.S.”<sup>14</sup>

2. Mr. James testified that Virgin America Inc. (“VAI”) is another of opposer’s trademark licensees operating in the United States.<sup>15</sup> As for the sales generated in the United States by VAI of Virgin-branded goods and services, Mr. James testified that “from August 2007 until June 2010, it was approximately \$1.3 billion.”<sup>16</sup> Mr. James did not provide any specifics as to the type or kind of goods and services sold by VAI under the Virgin brand. For advertising and promotion in the United States, Mr. James testified

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<sup>11</sup> As discussed *supra*, all submissions by opposer of printed publications on CD-ROMs and DVDs are in contravention of our rules and have not been considered as evidence.

<sup>12</sup> James Dep. 13:16-13:17, Oct. 19, 2010.

<sup>13</sup> James Dep. 26:20-27:10.

<sup>14</sup> James Dep. 30:21-30:23.

<sup>15</sup> James Dep. 13:24-13:25.

<sup>16</sup> James Dep. 27:23-27:25.

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that in 2007, VAI spent approximately \$12 million, in 2008, approximately \$11 million, and in 2009, approximately \$15 million.<sup>17</sup>

3. Mr. James testified that Virgin Mobile USA, LLC (“VMU”) is another of opposer’s trademark licensees operating in the United States.<sup>18</sup> Mr. James testified that VMU generated over \$1.1 billion in U.S. sales of Virgin-branded goods and services in 2006, \$1.3 billion in 2007, \$1.3 billion in 2008, and, for 2009, “up until the third quarter, it was \$937 million.”<sup>19</sup> Mr. James did not provide any specifics as to the type or kind of goods and services sold by VMU under the Virgin brand. Mr. James testified that VMU “spends on average more than \$20 million each year” to promote Virgin-branded phone products and services.<sup>20</sup>

4. Mr. James testified that one of opposer’s licensees, Virgin Entertainment Group, Inc., operated nineteen Virgin Megastores in the United States from 1992 until June 2009, with store locations including New York, Denver, Los Angeles and San Francisco, retailing “a wide range of Virgin-branded products,” including “clothing products, such as T-shirts and sweatshirts, bags, electronic products, playing cards, glasses [and] jewelry.”<sup>21</sup> Mr. James testified that these retail store services generated more than \$197 million in U.S. sales of Virgin-branded goods and services in 2006, \$188 million in

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<sup>17</sup> James Dep. 31:7-31:10.

<sup>18</sup> James Dep. 14:5-14:6.

<sup>19</sup> James Dep. 28:14-28:22.

<sup>20</sup> James Dep. 31:24-32:04.

<sup>21</sup> James Dep. 30:2-12, 35:14-23.

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2007, \$186 million in 2008, and \$153 million in 2009.<sup>22</sup> For advertising and promotion in the United States, Mr. James testified Virgin Megastores “spent more than \$10 million in 2006, and almost \$10 million in 2007, and for the period from 2008 until June 2009, it was almost \$15 million.”<sup>23</sup>

5. Mr. James authenticated a VAA press release of October 13, 2010, mentioning its selection as “ ‘Best Domestic Airline’ among U.S. carriers” in *Condé Nast Traveler’s* 2010 Readers’ Choice Awards.<sup>24</sup>

6. Mr. James authenticated an advertisement for VAA that appeared in a 2010 issue of the New Yorker magazine.<sup>25</sup>

7. Ms. Choi authenticated articles and that were printed in national publications between 2007 and 2008, including the Washington Post, the New York Times, Scientific American, Time magazine, the New Yorker, Bloomberg Businessweek, which referenced VIRGIN and VIRGIN-formative marks.<sup>26</sup>

8. Ms. Choi authenticated a DVD containing 126 digital clips from various nationally aired programs that aired between 2005 and 2009 on broadcast networks and

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<sup>22</sup> James Dep. 29:8-29:23.

<sup>23</sup> James Dep. 32:10-32:14.

<sup>24</sup> James Dep. 21:10-21:14.

<sup>25</sup> James Dep. 33:15-33 :17 (Dep. Ex. 54).

<sup>26</sup> Choi Dep. 25:25, 26:11, 32:16, 35 :4, 35 :24, 44:23, Oct. 18, 2011 (Dep. Exs. 15, 16, 20, 22-23, 31).

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cable television channels, including ABC, CBS, CNBC, Fox News, MSNBC, NBC and PBS.<sup>27</sup>

Opposer provided no supporting evidence or testimony regarding comparable statistics of sales and advertising figures of its leading competitors or its ranking in market share in respective product and service categories, and has provided little probative evidence of the general reputation or critical assessments in the consumer marketplace of the products and services branded with VIRGIN and VIRGIN-formative marks.

As for the printed publications, broadcast clips, and promotional video of record, many of these submissions show and contain references to VIRGIN and VIRGIN-formative marks, but nevertheless these have no or very little independent probative value, as these marks are only seen briefly or are mentioned only in passing. Generally, the goods and services branded with the marks are not the direct subject of the submissions. For example, opposer submitted a television clip from the Late Show with David Letterman, which aired on March 2, 2005.<sup>28</sup> The five-minute clip features a skit about the first solo nonstop unrefueled aircraft flight around the world. The flight was sponsored by opposer's founder and chairman, Richard Branson,<sup>29</sup> and the aircraft, which was owned and operated by the late Steve Fossett, was the Virgin Atlantic *GlobalFlyer*.<sup>30</sup> Letterman jokes, "I don't know much about aviation, but I do know this is absolutely a pointless exercise. This couldn't be a more pointless exercise. Me sitting down in this

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<sup>27</sup> Choi Dep. 18:21-19:23 (Dep. Ex. 11).

<sup>28</sup> Dep. Ex. 11 (*Late Show with David Letterman* (CBS television broadcast Mar. 2, 2005)).

<sup>29</sup> James Dep. 38:13-38:16.

<sup>30</sup> *Steve Fossett*, THE COLUMBIA ENCYCLOPEDIA (6th ed. 2008) (online edition).

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chair advances the cause of aviation more than this guy flying around the world solo. It means nothing.” The joking continues, and as Letterman says that the flight is reported to be over New York right then, a Virgin-branded toy airplane, pulled by a very visible wire, flies behind Letterman and across the set. There is no mention of VIRGIN in the segment. This clip is representative of the passing references to VIRGIN in many of the evidentiary submissions.

Opposer also argues that a prior finding by the U.S. Court of Appeals for the Second Circuit that its VIRGIN mark is a famous mark is “solid [precedent] upon which the Board may rely.”<sup>31</sup> However, opposer is incorrect; a “decision by another court based upon a different record is not evidence in this proceeding.” *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q.2d 1645, 1665 (TTAB 2010), *aff’d*, 637 F.3d 1344, 98 U.S.P.Q.2d 1253 (Fed. Cir. 2011). By statute, this Board has the duty to decide the right to federal registration in an opposition. 15 U.S.C. § 1067(a). “This duty may not be delegated by the adoption of conclusions reached by another court on a different record. Suffice it to say that an opposition must be decided on the evidence of record.” 94 U.S.P.Q.2d at 1665.

Similarly, opposer argues that we should find fame for its VIRGIN and VIRGIN-formative marks by extension of finding fame for Richard Branson, stating that he “is a globally recognized personality synonymous with the VIRGIN marks,” and as such, argues that Virgin-branded goods and services serve as secondary source indicators

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<sup>31</sup> Opposer’s Br. 33 (citing *Virgin Enters. Ltd. v. Nawab*, 335 F.3d 141, 67 U.S.P.Q.2d 1420 (2d Cir. 2003)).

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for Branson.<sup>32</sup> Opposer supports this argument with evidence of appearances by Branson and coverage of him via multiple forms of media. However, opposer cites to no caselaw to support its argument and the evidence fails to establish that the consumers purchasing Virgin-branded goods and services are even aware of the relationship between Branson and the goods and services at the time of purchase. Thus, there is neither fact nor governing or persuasive caselaw in the record to support opposer's argument.<sup>33</sup>

Despite these failings in the evidence submitted by opposer, based on the volume of sales and advertising expenditures of the Virgin-branded goods and services, the variety of goods and services bearing the mark, and the collective evidence presented that demonstrates achieved commercial success, a high degree of renown, and widespread exposure of the general public to opposer's VIRGIN and VIRGIN-formative marks in print and digital media, we find that the VIRGIN and the VIRGIN-formative marks are famous for purposes of likelihood of confusion for a wide variety of consumer goods and for services in the entertainment, telecommunications, transportation and travel fields.

Even though we have found that opposer has proven that its VIRGIN and VIRGIN-formative marks are famous for purposes of likelihood of confusion, fame alone is not sufficient to establish likelihood of confusion. If that were the case, having a famous mark would entitle opposer to a right in gross, and that is against the principles of trademark law. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps., Co.*, 703 F.2d

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<sup>32</sup> Opposer's Br. 34; Reply Br. 7.

<sup>33</sup> *But cf. Herman Miller, Inc. v. Palazzetti Imps. & Exps., Inc.*, 270 F.3d 298, 60 U.S.P.Q.2d 1633, 1646 n.7 (6th Cir. 2001) (finding that the renown of Charles and Ray Eames as the designers of a chair that became an iconic piece of modern American furniture does not automatically mean that consumers understand that the chair is manufactured by plaintiff).

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1372, 217 U.S.P.Q. 505, 507 (Fed. Cir. 1983). Accordingly, we must consider all relevant *DuPont* factors for which evidence has been introduced.

B. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

We now turn to the first *DuPont* factor, which focuses on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *E.g.*, *In re White Swan Ltd.*, 8 U.S.P.Q.2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 U.S.P.Q.2d 1041, 1042 n.4 (TTAB 1987). While marks must be compared in their entireties in the comparison analysis, if a mark comprises both a word and a design, the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. *E.g.*, *In re Dakin's Miniatures, Inc.*, 59 U.S.P.Q.2d 1593, 1596 (TTAB 1999).

In comparing the marks, we are mindful that the test for similarity is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods or services offered under the respective marks is likely to result. *E.g.*, *Sakrete, Inc. v. Slag Processors, Inc.*, 305 F.2d 482, 134 U.S.P.Q. 245, 247 (C.C.P.A. 1962). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 U.S.P.Q. 335, 344 (TTAB 1980). We are also mindful that famous marks enjoy wide latitudes of legal protection. *E.g.*, *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir.



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1992). “As a mark’s fame increases, the [Trademark] Act’s tolerance for similarities in competing marks falls.” *Id.*

With these principles in mind, we begin our analysis by finding that the respective marks are similar in appearance and sound because they share the identical term “VIRGIN,” which we take judicial notice is defined, *inter alia*, as follows:

adj. 1. Of, relating to, or being a virgin; chaste. 2. Being in a pure or natural state; unsullied: *virgin snow*. 3. Unused, uncultivated, or unexplored: *virgin territory*. 4. Existing in native or raw form; not processed or refined.<sup>34</sup>

Depending on commercial context, the term “VIRGIN” would likely describe or suggest natural, uncultivated, and unprocessed goods and services to the relevant consumer. In this case, the relevant customers who would encounter both applicant’s goods and opposer’s goods and services would be purchasers of agricultural grains, seeds, bulbs and similar products for planting and related agricultural purposes.

Applicant’s mark incorporates opposer’s entire VIRGIN mark. Likelihood of confusion has frequently been found where one mark incorporates the entirety of another mark. *See, e.g., Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 U.S.P.Q. 105, 106 (C.C.P.A. 1975) (BENGAL for gin and BENGAL LANCER for nonalcoholic club soda, quinine water and ginger ale); *Johnson Publ’g Co. v. Int’l Dev. Ltd.*, 221 U.S.P.Q. 155, 156 (TTAB 1982) (EBONY for cosmetics and EBONY DRUM for hairdressing and conditioner); *In re S. Bend Toy Mfg. Co.*, 218 U.S.P.Q. 479, 480 (TTAB 1983) (LIL’ LADY BUG for toy doll carriages and LITTLE LADY for doll clothing); *Helga, Inc. v. Helga Howie, Inc.*, 182 U.S.P.Q. 629, 630 (TTAB 1974) (HELGA for women’s clothing and HELGA HOWIE for women’s clothing); *In re Hepperle*, 175

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<sup>34</sup> AM. HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1921 (4th ed. 2006).

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U.S.P.Q. 512, 512 (TTAB 1972) (applicant's mark ACAPULCO GOLD for suntan lotion is likely to cause confusion with ACAPULCO for lipstick and powder). In addition, VIRGIN is the first or only term in all the marks, which often supports finding that marks are similar. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”); e.g., *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1692 (Fed. Cir. 2005) (“The presence of this strong distinctive term as the first word in both parties’ marks renders the marks similar.”).

However, because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the test for similarity cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985); e.g., *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 U.S.P.Q. 233, 234 (C.C.P.A. 1981) (“It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion.”).

Applicant contends that his mark, in its entirety, engenders a different commercial impression than any of opposer’s marks of record. Applicant states that the mark “VIRGINFARMS” denotes “soil’s return to an undefiled state, which allows for the growth of nutrient dense foods, for human consumption, and seeds for the next planting season.”<sup>35</sup> During prosecution of the application, applicant agreed to disclaim both terms

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<sup>35</sup> Applicant’s Br. 4–5.

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of his mark. Supporting applicant's contention regarding the mark's commercial impression, we take judicial notice that "VIRGIN SOIL" is defined as "soil in its natural state as distinguished from soil or land that has been plowed or otherwise altered by humans for cultivated crops or other uses."<sup>36</sup> It would appear to be applicant's position that the literal elements of his mark describe a characteristic and purpose of the goods. On the other hand, applicant contends that none of opposer's marks "is descriptive of any of [its] numerous products."<sup>37</sup> We have previously found that differences in connotation can outweigh visual and phonetic similarities. *E.g.*, *Coach Servs. Inc. v. Triumph Learning LLC*, 96 U.S.P.Q.2d 1600, 1609 (TTAB 2010), *aff'd* 668 F.3d 1356, 101 U.S.P.Q.2d 1713 (Fed. Cir. 2012) (finding "COACH" for educational materials calls "to mind a tutor who prepares a student for examination," while "COACH" for leather handbags, fashions, and accessories is "arbitrary or suggestive of carriage or travel accommodations"); *Blue Man Prods. Inc. v. Tarmann*, 75 U.S.P.Q.2d 1811, 1820–21 (TTAB 2005) (finding that while the marks were very similar in appearance and pronunciation, opposer's "BLUE MAN GROUP" conjured the image of the performers, while applicant's "BLUE MAN" mark made no such connotation for cigarettes or tobacco, and these differences outweighed the similarities); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (finding "PLAYERS" for shoes engenders a different commercial impression from "PLAYERS" for underwear).

Contrary to applicant's contention, we find that applicant's mark is suggestive, and opposer's marks include both suggestive and arbitrary marks. Applicant's

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<sup>36</sup> DELMAR'S AGRISCIENCE DICTIONARY WITH SEARCHABLE CD-ROM 249 (2000).

<sup>37</sup> Applicant's Br. 7.

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“VIRGINFARMS” in relation to his listed goods is suggestive of organic farming. Some of opposer’s marks, for example, “VIRGIN ATLANTIC” for transportation and tour conducting services, suggest venturing to the unexplored. While we do not agree with opposer’s assertion that applicant’s “use of a descriptive term after VIRGIN increases the likelihood of confusion,”<sup>38</sup> we do find that the root term of applicant’s and opposer’s marks, VIRGIN, is a term that means unsullied, uncultivated and unexplored, and that all the marks engender a similar connotation based on this meaning. In addition, we have already found that the VIRGIN and VIRGIN-formative marks are famous marks for purposes of likelihood of confusion. The fame of VIRGIN magnifies the significance of the similarities of the mark. Balancing both the similarities and differences between the marks, and giving due weight to the fame of opposer’s marks, we find that the marks are similar.

C. The similarity or dissimilarity and nature of the goods in the application and the goods and services in opposer’s registration, likely-to-continue channels of trade and classes of consumers.

In determining whether goods and services are related, the second *DuPont* factor requires that we must consider the goods and services as they are identified in the respective descriptions in the application and registrations. *E.g.*, *Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973). It is not necessary that the goods and services of applicant and opposer be similar or competitive to support a holding of likelihood of confusion. It is sufficient that the goods and services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise,

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<sup>38</sup> Opposer’s Br. 36.

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because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source. *Miss Universe L.P. v. Community Mktg. Inc.*, 82 U.S.P.Q.2d 1562, 1568 (TTAB 2007).

In addition, we must accord “full weight to the fame of a famous mark when analyzing likelihood of confusion between products that [are] not closely related.” *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1898 (Fed. Cir. 2000). For example, in *McDonald’s Corp. v. McKinley*, 13 U.S.P.Q.2d 1895, 1898 (TTAB 1990), we found opposer’s restaurant services, food and beverages, and promotional toy and game products sufficiently related to applicant’s hand-crafted teddy bears, based on opposer’s showing that it distributed an extremely large number of various toys under the famous MCDONALD’S and MC-formative marks as promotional items and incentive awards in connection with its restaurant services, such that those encountering applicant’s bears under its MCTEDDY mark would assume they originated or were associated with opposer. In *Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 U.S.P.Q.2d 1835, 1842–43 (TTAB 1989), we found relatedness of opposer’s jewelry and household goods and related retail services under its famous TIFFANY mark and applicant’s automobiles under its CLASSIC TIFFANY mark, based on opposer’s showing that applicant’s advertising associated its mark with luxury and references to jewelry, which it established created a nexus with its goods, reputation and goodwill, sufficient to create a mistaken belief that applicant’s goods were associated with or sponsored by opposer.

Here, there are clear and significant differences between applicant’s goods and the various goods and services identified in opposer’s registrations of record. Applicant is seeking to register his mark for “agricultural grains for planting; agricultural seeds; bulbs

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for agricultural purposes; plantable seed paper comprised primarily of seeds for agricultural purposes; seeds for agricultural purposes; spores and spawn; unprocessed seeds for agricultural use.” The scope of these goods is grains, seeds and related items used for planting, and the explicit limitation of these products is that they are for agricultural purposes and not for human consumption. Meanwhile, opposer has VIRGIN and VIRGIN-formative marks registered in connection with a variety of goods and services, generally summarized as musical recordings, printed materials in the entertainment field, writing instruments, playing cards, clothing, non-alcoholic and alcoholic beverages, cosmetics and body care preparations, cell phones, small electronics, articles of luggage and carrying bags, jewelry, transportation services, restaurant and bar services, mail order catalog and retail store services, advertising and public relations services, photography services, printing services, travel agency services, insurance and financial services, charitable fundraising services, computerized communication and transmission services, body care services, online computer game services, educational services in the social issue and charity fields, organizing sporting and cultural activities, and library facility services.

Determinations are reached based on the evidence of record. Unlike the evidence identified in the *McDonald's* and *Tiffany & Co.* decisions, opposer has not shown that applicant's goods would be related to opposer's goods and services in the mind of the relevant consuming public, or that applicant's use of the mark will lead consumers to believe that applicant's goods are associated with or sponsored by opposer, based on the fame of opposer's VIRGIN and VIRGIN-formative marks. Opposer asserts that the evidence supports a relationship between applicant's goods and its goods and services

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because all include “agricultural aspects and influence agricultural production.”<sup>39</sup> To support this assertion, it provides the following example:

[T]he Virgin Group’s airport lounges and airlines might purchase and serve sunflower seeds from VirginFarms. There can be no doubt that a Virgin Group<sup>40</sup> airline passenger who receives a package of VirginFarms’ sunflower seeds will be confused as to the source of those seeds. Likewise, VirginFarms’ grains and seeds might be used in the production of biofuels by the Virgin Group’s licensees or, worse, their competitors.<sup>41</sup>

However, the record evidence does not support opposer’s assertion. First, there is no evidence that applicant is seeking to use his mark in connection with edible sunflower seeds, as this application lists items limited to agricultural use only; therefore, the confusion theorized in this example for opposer’s airline passenger would not result if this application proceeded to registration. Second, opposer has introduced no evidence to establish that seeds for agricultural purposes could be used in the production of biofuels, and there is no evidence that applicant is seeking to use its mark in connection with any grains and seeds that are potentially capable of being used in the production of biofuels; therefore, again, there is nothing in the record to support the theorized harm to opposer should this application proceeded to registration.

The third *DuPont* factor involves how and to whom the goods and services at issue are sold or marketed. We must determine, therefore, whether there is likely to be an overlap between the respective purchasers and users of the goods and services of the parties. *Elec. Design & Sales v. Elec. Data Sys.*, 954 F.2d 713, 21 U.S.P.Q.2d 1388, 1390

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<sup>39</sup> Opposer’s Br. 38.

<sup>40</sup> In its brief, opposer defined “Virgin Group” as the collective of opposer along with its licensees and affiliates. Opposer’s Br. 6.

<sup>41</sup> Opposer’s Br. 38.

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(Fed. Cir. 1992). Since applicant's description of goods is limited to agricultural purposes, the listed goods travel in only those normal channels involving goods for agricultural purposes. However, since those consumers buying seeds and like products for agricultural purposes would also likely buy phones and travel, these consumers may encounter both sets of marks. *In re Elbaum*, 211 U.S.P.Q. 639, 640 (TTAB 1981); *see Paula Payne Prods. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 U.S.P.Q. 76, 77 (C.C.P.A. 1973); *Kalart Co. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 U.S.P.Q. 139, 139–40 (C.C.P.A. 1958). Opposer's registrations have no limitations as to trade channels or classes of purchasers.

The vast difference between grains for planting, spores, and seeds for agricultural use and all of opposer's goods and services would not be lost on average purchasers, let alone those agricultural customers who buy agricultural seeds and grains for commercial planting and farming. By limiting his goods to those for agricultural planting purposes, applicant has limited its channels of trade to those that are unlikely to include opposer's listed goods and services. Moreover, while opposer asserts that its goods and services include agricultural aspects and influence agricultural production, opposer has not provided evidence that supports this assertion in the record.<sup>42</sup> While some of opposer's submissions through its notices of reliance relate to agricultural production, especially outside of the United States, printed publications and broadcast programming clips may not be used to prove the truth of the matters asserted therein, as that would constitute reliance on hearsay. Thus, we have no basis on which to conclude that the relevant

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<sup>42</sup> In its brief, opposer mentions the Virgin Group's Sow-A-Seed program, and asserts that applicant "may very well sell the seeds used" in the program, which it states "turns vacant pieces of land into thriving veggie gardens." Opposer's Br. 8, 21. No evidence regarding the existence of this program in the United States is of record.



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purchasers would believe that applicant's goods are associated with or sponsored by opposer.

Though not directly argued, opposer suggests that since the Virgin Group uses the VIRGIN and VIRGIN-formative marks in connection with "a vast array of goods and services,"<sup>43</sup> and the "public has an expectation that the Virgin Group will introduce new and different products and services on a regular basis,"<sup>44</sup> agricultural seeds and related goods for planting are within opposer's natural expansion of trade. Since opposer did not introduce any evidence supporting its invocation of the doctrine of natural expansion, we have not resorted to this analysis when considering the relatedness of the goods and services in this case.<sup>45</sup>

When a mark is famous, the degree of relatedness of the goods need not be as great. *See Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894, 1897–98 (Fed. Cir. 2000). However, there must be something more than just a similarity of marks to show this relatedness or, again, the owner of a famous mark would have a right in gross. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps., Co.*, 703 F.2d 1372, 217 U.S.P.Q. 505,

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<sup>43</sup> Opposer's Reply Br. 14.

<sup>44</sup> Opposer's Br. 8.

<sup>45</sup> "Before the doctrine of natural expansion may be invoked by opposer, it must be shown that the new goods, *i.e.*, the extension of the line of business from that which pre-existed applicant's arrival, evolved from the manufacturing and marketing activities of opposer and did not result from the acquisition of a new business by a diversifying company. The burden is on opposer to present evidence that is persuasive of the fact that the new business represents an expansion of, and not merely an unrelated addition to, the business that opposer conducted prior to the first use of applicant's mark on the goods for which applicant is seeking a registration. Without such evidence of a natural expansion, opposer would be asserting the dreaded right in gross to a mark." *Sheller-Globe Corp. v. Scott Paper Co.*, 204 U.S.P.Q. 329, 333–34 (TTAB 1979) (internal citations omitted).

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507 (Fed. Cir. 1983). We find that the goods and services at issue are not related and that the channels of trade are distinct.

Thus, the second and third *DuPont* factors, regarding the similarity or dissimilarity of the goods and services and likely-to-continue channels of trade favor applicant.

D. The conditions under which and buyers to whom sales are made (*i.e.*, impulse vs. careful, sophisticated purchasing).

Considering the particular nature of applicant's goods, we have no doubt that purchasing decisions would not be made impulsively or carelessly, as purchasing grains, seeds, bulbs and other goods used to yield successful farming and agricultural growth would be a purchase of some deliberation and analysis.

In addition, even though professional farmers exercising a higher degree of care are not immune to trademark confusion, the circumstances of purchasing such items would reduce source confusion. Thus, this fourth *DuPont* factor favors applicant.

E. Balancing the factors.

While our findings for purposes of likelihood of confusion are that opposer's marks are famous and the marks are similar, opposer is not entitled to a right in gross. Opposer has failed to show that the respective goods and services are similar, let alone related. Meanwhile, applicant's goods move in agricultural fields, while opposer's would not. Thus, we find that applicant's use of his VIRGINFARMS mark for "agricultural grains for planting; agricultural seeds; bulbs for agricultural purposes; plantable seed paper comprised primarily of seeds for agricultural purposes; seeds for agricultural purposes; spores and spawn; unprocessed seeds for agricultural use" is not likely to cause confusion with opposer's VIRGIN and VIRGIN-formative marks as used in connection with the listed goods and services in its registrations of record.

Dilution

In addition to its Section 2(d) claim, opposer has asserted a dilution claim. The Trademark Dilution Revision Act of 2006 (“TDRA”) provides for a cause of action for the dilution of famous marks. 15 U.S.C. §§ 1063, 1125(c). The TDRA states that:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

15 U.S.C. § 1125(c)(1).

Opposer contends that the marks are so similar, “dilution by blurring is inevitable.”<sup>46</sup> Section 43(c)(2)(B) of the TDRA states the following:

‘[D]ilution by blurring’ is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.

15 U.S.C. § 1125(c)(2)(B).

With respect to fame, the dilution analysis requires our consideration of the following issues in determining opposer’s dilution claim:

1. Whether VIRGIN is a famous mark;
2. Whether VIRGIN became famous prior to the filing date of applicant’s application (March 20, 2009); and
3. Whether VIRGINFARMS and design is likely to cause dilution by blurring of the distinctiveness of VIRGIN and VIRGIN-formative marks.

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<sup>46</sup> Opposer’s Br. 46.

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A. Whether opposer's mark is famous for purposes of dilution.

Although we have found VIRGIN famous for purposes of opposer's likelihood of confusion claim, we must now determine whether VIRGIN is famous in the context of a dilution claim. Fame for dilution purposes is a distinct concept from fame for likelihood of confusion purposes, with dilution fame requiring a more stringent showing. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 U.S.P.Q.2d 1713, 1724 (Fed. Cir. 2012). Likelihood of confusion fame "varies along a spectrum from very strong to very weak," *In re Coors Brewing Co.*, 343 F.3d 1340, 68 U.S.P.Q.2d 1059, 1063 (Fed. Cir. 2003), while dilution fame is an "either-or" proposition—it either exists or it does not. 101 U.S.P.Q.2d at 1724. The bar for establishing dilution fame is set extremely high. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1170 (TTAB 2001).

In *Toro*, we stated that "[f]ame for dilution purposes is difficult to prove," as to establish the requisite level of fame, the "mark's owner must demonstrate that the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner's use of the mark." 61 U.S.P.Q.2d at 1180.<sup>47</sup> An opposer must show that, when the general public encounters the mark "in almost any context, it associates the term, at least initially, with the mark's owner." *Id.* at 1181. Evidence to show the transformation of a term into a truly famous mark may include recognition by the other party, intense media attention, and surveys. *Id.* In short, an opposer must show that its marks have become "household terms which almost everyone is familiar." *Id.*

Opposer's evidence fails to meet the *Toro* threshold showing of fame. First, the printed publication articles and broadcast clips do not show Virgin-branded goods and

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<sup>47</sup> Although the *Toro* opinion predates the TDRA, its analysis remains relevant.

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services as the subject or focus, and thus, the media evidence fails to show a widespread recognition of opposer's marks to the general population. Most of the broadcast clips reference or show the VIRGIN marks in passing or inconsequentially. For example, in a television clip of five-minutes and forty-three seconds, which aired on CBS's "The Early Show" on February 9, 2007, regarding a \$25-million prize offered by former Vice President Al Gore and Richard Branson to seek a solution to global warming, the only reference to VIRGIN is to inform viewers that Branson is the CEO and chairman of Virgin Group; there is not a single reference to Virgin-branded goods and services.<sup>48</sup> Similarly, in a television clip of four-minutes and twenty-two seconds, which aired on CNN's "Anderson Cooper 360°" on May 24, 2007, regarding Branson's participation on an Arctic expedition, the only reference to VIRGIN is to inform viewers that Branson is the CEO of Virgin Atlantic.<sup>49</sup> Most of the evidence consisting of printed publications similarly is not about a broad variety of Virgin-branded goods and services, but rather initiatives and investments in which Branson is a participant or leader. Second, opposer did not submit survey evidence of brand recognition and awareness.<sup>50</sup> Third, applicant has not stated that it recognized opposer as famous.

An example of the quantum and quality of sufficient evidence to establish dilution fame is the evidence introduced in *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 U.S.P.Q.2d 1718 (TTAB 2003). In that decision, we found that the NASDAQ mark was

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<sup>48</sup> Dep. Ex. 11 (*The Early Show* (CBS television broadcast Feb. 9, 2007)).

<sup>49</sup> Dep. Ex. 11 (*Anderson Cooper 360°* (CNN television broadcast May 24, 2007)).

<sup>50</sup> We are aware that opposer is not required to introduce a survey to establish that its mark is famous for purposes of our dilution analysis and we are not making a requirement.

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famous for its stock market services. The record included market studies demonstrating that the awareness of opposer's stock market among investors reached more than 80% in 1999 from just above 20% in 1990. 69 U.S.P.Q.2d at 1729. Opposer introduced evidence that its NASDAQ-branded website received seven million daily views, its daily market results appeared in hundreds of newspapers, broadcasting stations and websites, and its NASDAQ-listed companies received separate and significant media coverage as NASDAQ traded companies. *Id.* In view of the foregoing, we find that opposer has not established that VIRGIN is famous for dilution purposes.

On this record, opposer cannot prevail on its dilution claim because we have found that opposer has not met its burden of proving that its VIRGIN marks are famous for purposes of dilution. Nevertheless, for purposes of completeness, we discuss whether the VIRGIN marks were capable of being famous prior to the filing date of applicant's application, and dilution by blurring and tarnishment.

B. When were opposer's marks capable of being famous based on the evidence?

In the event that this case is appealed and the reviewing court finds that based on opposer's record, the VIRGIN and VIRGIN-formative marks are famous, we find that such fame has been established prior to the filing date of the application (March 20, 2009).

Based on Mr. James' testimony regarding opposer's sales and advertising expenditures of VAA, VAI, and VMU regarding Virgin-branded goods and services, we would be able to find that opposer's mark became famous prior to the filing date of the application.

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C. Whether VIRGINFARMS and design is likely to cause dilution by blurring of the distinctiveness of the VIRGIN and VIRGIN-formative marks.

The Board may look to all relevant facts in determining whether applicant's VIRGINFARMS mark will blur the distinctiveness of opposer's VIRGIN and VIRGIN-formative marks. The Trademark Act provides the following guidance:

In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i)-(vi).

1. The degree of similarity between the mark or trade name and the famous mark.

In analysis of dilution by blurring, marks are compared under the test for similarity for likelihood of confusion purposes. *Nike Inc. v. Maher*, 100 U.S.P.Q.2d 1018, 1030 (TTAB 2011). As in the analysis provided *supra*, we find that the marks are more similar than dissimilar.

Because we find that the marks are similar, this factor favors opposer.

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2. The degree of inherent or acquired distinctiveness of the famous mark.

As indicated previously, VIRGIN is a suggestive term when used in connection with agricultural planting goods, and is inherently distinctive in connection with opposer's listed goods and services. Accordingly, because VIRGIN is inherently distinctive, this dilution factor favors opposer.

3. The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

Opposer has introduced evidence of trademark opposition and infringement action litigation consisting of 67 non-precedential Board decisions and 62 court judgments in the United States.<sup>51</sup> Opposer also introduced evidence of its trademark licensing in the United States.<sup>52</sup> This evidence demonstrates opposer's enforcement efforts and measures to have substantially exclusive use of VIRGIN and VIRGIN-formative marks. Thus, we conclude that opposer has maintained substantially exclusive use of the VIRGIN and VIRGIN-formative mark, and therefore, this dilution factor favors opposer.

4. The degree of recognition of the famous mark.

This congressionally mandated factor seems redundant in view of the fact that opposer must establish that its mark is famous as a prerequisite for establishing a dilution claim. Nevertheless, we must consider this factor in accordance with the statute. We conclude, therefore, that the degree of recognition of the famous mark requires us to determine the level of fame acquired by the famous mark. In other words, once the mark is determined to be famous as a prerequisite for dilution protection, we must apply a sliding

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<sup>51</sup> James Dep. 10:6-12:6; Opposer's Exs. 1-111.

<sup>52</sup> James Dep. 12:9-16:20 (Dep. Ex. 46A).



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scale to determine the extent of that protection (*i.e.*, the more famous the mark, the more likely there will be an association between the famous mark and the defendant's mark).

As indicated above, we have found that VIRGIN is famous for purposes of likelihood of confusion, but not for purposes of dilution. Thus, VIRGIN has not acquired an extraordinary degree of recognition such that it “is now primarily associated with the owner of the mark even when it is considered outside of the context of the owner's goods and services” such that the mark has become part of the vernacular. *Toro Co. v. ToroHead, Inc.*, 61 U.S.P.Q.2d at 1180–81. Accordingly, we find that this dilution factor favors applicant.

5. Whether the user of the mark or trade name intended to create an association with the famous mark.

Opposer failed to present any evidence demonstrating that applicant intended to create an association with its VIRGIN and VIRGIN-formative marks. There no evidence showing that applicant tried to create an association with opposer's mark. In view thereof, this dilution factor favors applicant.

6. Any actual association between the mark or trade name and the famous mark.

Opposer failed to present any evidence demonstrating that there is any actual association between applicant's VIRGINFARMS mark and its VIRGIN and VIRGIN-formative marks. Since we have no evidence on which to conclude that potential customers of applicant's products would make any association between the parties' marks when used on their respective products and in connection with opposer's services, this dilution factor favors applicant.

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7. Balancing the factors.

The finding that opposer's VIRGIN and VIRGIN-formative marks are not famous for purposes of dilution, the fact that there is no evidence demonstrating any association between the parties' marks, and the fact that there is no evidence that applicant intended to create an association with opposer's mark outweigh the similarities of the marks and the distinctiveness and substantially exclusive use of opposer's VIRGIN and VIRGIN-formative marks. Based on the record before us, opposer has not demonstrated that the registration of applicant's VIRGINFARMS mark will dilute its VIRGIN and VIRGIN-formative marks by blurring.

D. Dilution by tarnishment.

There is no evidence in this record suggesting that opposer's VIRGIN and VIRGIN-formative marks will suffer any negative association by applicant's use of his mark. In view of the foregoing, opposer has failed to prove its claim of dilution by tarnishment.

**Decision:** The opposition is dismissed with prejudice.